

KBR/JSG:cf 7/13/05 392555.doc 302308.2
PATENT

Attorney Reference Number 3382-63898-01
Application Number 10/058,693

Remarks

The Applicants respectfully request reconsideration of the application in view of the following remarks. Claims 1-15 are pending in the Application.

Claim Rejections – 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-15 as being unpatentable over U.S. Publication No. 2002/0122067 A1 to Geigel et al. ["Geigel"] in view of U.S. Publication No. 2002/0126141 A1 to Mastronardi ["Mastronardi"].

I. Geigel and Mastronardi, taken separately or in combination, fail to teach or suggest several limitations in each of claims 1-15

Geigel and Mastronardi, taken separately or in combination, fail to teach or suggest several limitations of each of claims 1-15. Geigel and Mastronardi, taken separately or in combination, fail to teach or suggest the following language of claims 1, 6, and 11, respectively.

Claim 1 recites:

- b) displaying, to a user, the group of images for which corresponding image files are available;
- c) prompting the user to select a plurality of images from the group;
- d) receiving input from the user by which the user selects one or more images from the group;
- e) prompting the user to save the selected images as an album of images;

Claim 6 recites:

- b) display, to a user, the group of images for which corresponding image files are available;
- c) prompt the user to select a plurality of images from the group;
- d) receive input from the user by which the user selects the plurality of images from the group;
- e) prompt the user to save one or more of the selected images as an album of images;

Claim 11 recites:

- b) means for displaying, to a user, the group of images for which corresponding image files are available;

KBR/JSg:cf 7/13/05 392555.doc 302308.2
PATENT

Attorney Reference Number 3382-63898-01
Application Number 10/058,693

- c) means for prompting the user to select a plurality of images from the group;
- d) means for receiving input from the user by which the user selects one or more images from the group;
- e) means for prompting the user to save the selected images as an album of images;

Geigel does not teach or suggest, and in fact leads away from, the above-cited language of claims 1, 6, and 11, respectively. [M.P.E.P 2141.02, PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS.]

As the Applicants have explained previously, Geigel describes a system and method for automatic layout of images in digital albums. [Geigel, Abstract.] The user inputs into the Geigel system an entire collection of images, such as from a digital camera. [See Geigel, ¶¶ [0055], [0056].] The Geigel system does not display images and prompt the user to select images to be included in an album from the collection of images that were input. In contrast, in several respects, Geigel teaches directly away from prompting for such input from the user:

[0055] A complete *albuming automation* system utilizes various image science algorithms and techniques including advanced event clustering, dud detection, image appeal and automatic page layout. In an illustrative embodiment, the emphasis of such a system is for a "DAFY" (Do-it-All-For-You) like product, where the user inputs a collection of images and the system produces an album (a collection of images) *with minimal input from the user*.

[emphasis added; see also paragraph [0009].]

Automating album creation with minimal input from the user (as in Geigel) leads directly away from prompting a user and receiving input as recited in claims 1, 6, and 11, respectively. Further, Geigel describes the automated system as including "Dud/Duplicate Detection" in paragraph [0061]. *Automated* processing to detect "dud" or "duplicate" pictures also leads away from the above-cited language of claims 1, 6, and 11, respectively.

The Examiner states that Geigel teaches "prompting the user to select a plurality of images from the group" at paragraph [0010], noting that paragraph [0010] includes the language "assigning image objects to a page based on user preferences." [Office Action at 2.] The Applicants respectfully disagree. Paragraph [0010] of Geigel describes part of an "automated album layout method" that takes a set of image objects and assigns "*each* image object to a page." [Emphasis added.] After the automatic method has created a page of the album, the page may then be displayed for "distribution refining" based on user input. [Geigel at ¶ [0010].] The "distribution refining" involves refinement of

KBR/JSJ:cf 7/13/05 392555.doc 302308.2
PATENT

Attorney Reference Number 3382-63898-01
Application Number 10/058,693

user-specified graphic design parameter preferences, [see Geigel at ¶¶ [0056], [0085]], but does not involve assignment or selection of the constituent images for an album. Specifying or refining graphic design parameter preferences for a page but not constituent images (as in Geigel) leads away from the above-cited language of claims 1, 6, and 11, respectively.

Stated another way, the Applicants respectfully submit that paragraph [0010] of Geigel fails to disclose or suggest the above-cited language for at least two reasons. First, paragraph [0010] discusses assigning *each* image object to a particular album page, not selecting images from a group for inclusion in an album. Paragraph [0010] does not discuss selecting which images will be included in the album, only *where* the images will be placed in the album. Second, even assignment of the images to particular pages is not done by the user. Rather, it is done “according to a fitness function’s parameters of a genetic engine.” [Geigel at ¶ [0010].] Later, Geigel states more specifically that a particular automated module, not the user, is responsible for determining which images are assigned to a particular page: “The Page Creator Module 126 is responsible for assigning each image to an album page.” [Geigel at ¶ [0077].] Therefore, if anything, Geigel’s description regarding placement of images on particular pages leads away from the above-cited language of claims 1, 6, and 11, respectively.

The Examiner did not assert that Mastronardi teaches the above-cited language of claims 1, 6, and 11. The Applicants have discussed Mastronardi in their previous responses. As discussed there, Mastronardi does not involve selecting images *for an album of images*. Accordingly, Mastronardi does not teach or suggest the above-cited language from claims 1, 6, and 11, respectively, and does not make up for the deficiencies of Geigel with respect to those claims.

The Examiner makes several assertions in response to the Applicants’ previous arguments as to the claim language discussed above. The Applicants will address them in turn. First, the Examiner asserts that the Applicants’ arguments are merely “a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.” [Office Action at 5.] However, the Applicants respectfully submit that the arguments herein and in previous responses discuss specific language of the claims that is not taught or suggested by Geigel and Mastronardi, either alone or in combination.

Second, the Examiner asserts that the Applicants “merely address some but not all said limitations.” [Office Action at 5.] However, the Applicants respectfully submit that they do not need

KBR/JSQ:cf 7/13/05 392555.doc 302308.2
PATENT

Attorney Reference Number 3382-63898-01
Application Number 10/058,693

to address all the claim limitations. It is the Examiner's burden to show that the entire combination of claim limitations is taught or suggested by the prior art. [M.P.E.P 2143.03, ALL CLAIM LIMITATIONS MUST BE TAUGHT OR SUGGESTED.] Accordingly, the Applicants only need to point to one or more limitations that are not taught or suggested by any of the references. The Applicants have done so. Indeed, they have pointed to more than one such limitation.

Third, the Examiner argues that the following language from the Geigel Abstract teaches displaying images and prompting the user to select images to be included in an album from the collection of images that were input: "When a suitable layout has been generated, a *final* album output is generated, which may be displayed, printed" [Office Action at 6 [emphasis added].]. Geigel does not teach or suggest a system that prompts a user to select images from the displayed images to be included in the album. Indeed, it would be illogical for a system to prompt a user to select images from the "final album" in the referenced quotation because the album is already *finalized*.

Fourth, the Examiner argues that the broadest reasonable interpretation of claim language can be used, and that Geigel teaches that data is derived from actual user images corresponding to user selected images, citing to paragraph [0112] of Geigel. [Office Action at 6.] The Applicants respectfully note that it is unclear what claim language is being interpreted by the Examiner here, how that language is being interpreted, or how paragraph [0112] meets the language as interpreted. Paragraph [0112] merely discusses the emphasis and chronology values that are used by the page creation module to automatically assign images of the album to pages of the album. Indeed, the images of the album come from "*a typical user role [sic] of film consisting of 40 images*" [Geigel at ¶ [0112].] Using the images from a roll of film to automatically create an album in no way teaches or suggests "displaying, to a user, the group of images for which corresponding image files are available; prompting the user to select a plurality of images from the group; receiving input from the user by which the user selects one or more images from the group; [and] prompting the user to save the selected images as an album of images," as recited in claim 1. It likewise fails to teach or suggest the above-cited limitations of claims 6 and 11.

Fifth, the Examiner argues that the background of Geigel teaches software applications that assist in "manual creation of digital photo albums." [Office Action at 6.] This is insufficient to teach or suggest the above-cited language of claims 1, 6, and 11, respectively, for at least two reasons. First, Geigel in no way suggests that the features of these prior manual software applications should be

KBR/JSG:xf 7/13/05 392555.doc 302308.2
PATENT

Attorney Reference Number 3382-63898-01
Application Number 10/058,693

combined with Geigel's system. Indeed, in the same paragraph cited by the Examiner, Geigel criticizes such systems: "The drawback with such applications is that they require a large amount of user interaction, which does not yield much improvement over conventional, paper-based alburning techniques of the past. Therefore, the task is less likely to be completed due to the significant amount of effort required to accomplish it." [Geigel at ¶ [0005].] Geigel then goes on to state the perceived need for an automated alburning system that "minimizes input from the user." [Geigel at ¶¶ [0008]-[0009].] Accordingly, Geigel teaches away from having more user interaction. Second, even if Geigel describes manual creation of photo albums using software (as the Examiner contends), that does not teach or suggest the above-recited language of the Applicants' claims. For example, there is no teaching or suggestion that these prior software applications would display, to a user, the group of images for which corresponding image files are available; prompt the user to select a plurality of images from the group; receive input from the user by which the user selects one or more images from the group; and prompt the user to save the selected images as an album of images, as recited in claim 1.

Sixth, the Examiner argues that the Applicants admit there is some user input in Geigel, even if it is minimal. However, the claims do not cover just any user input. To render one of the Applicants' claims obvious, the references must teach or suggest the combination of claim language recited in the claim. [M.P.E.P 2143.03, ALL CLAIM LIMITATIONS MUST BE TAUGHT OR SUGGESTED.] The references cited by the Examiner fail to do that, and that failure is not remedied by a general reference to minimal user input.

Seventh, with regard to Mastronardi, the Examiner first disagrees with the Applicant's statement that "Mastronardi does not involve selecting images for an album of images." [Office Action at 7.] However, the Examiner goes on to apply Mastronardi only against claim language about compressing image file copies, not against other claim language. [Office Action at 7.] Accordingly, there appears to be no real disagreement about the fact that Mastronardi does not teach or suggest the language of claims 1, 6, and 11 recited above.

Moreover, Geigel and Mastronardi, taken separately or in combination, fail to teach or suggest the following language of claims 1, 6, and 11, respectively.

Claim 1 recites:

- g) making a copy of each image file that corresponds to one of the selected images to result in image file copies;

KBR/JSQ:cf 7/13/05 392555.doc 302308.2
PATENT

Attorney Reference Number 3382-63898-01
Application Number 10/058,693

- h) compressing the image file copies.

Claim 6 recites:

- g) make a copy of each image file that corresponds to one of the one or more selected images to result in one or more image file copies;
- h) compress the one or more image file copies.

Claim 11 recites:

- g) means for making a copy of each image file that corresponds to one of the selected images to result in image file copies.;
- h) means for compressing the image file copies.

Geigel fails to teach or suggest the above-cited language of claims 1, 6, and 11, respectively. Indeed, once again Geigel teaches directly away from the claim language. [M.P.E.P 2141.02, PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS.] Geigel describes processing input images and then producing an output, but does not teach or suggest making and compressing copies of the underlying image files. [See, e.g., Geigel Fig. 1.]

In the Office Action, the Examiner cited paragraph [0061] of Geigel as disclosing, for example, “making a copy of each image file....” [Office Action at 3.] Paragraph [0061] describes a “Dud/Duplicate Detection” method. This paragraph does not teach or suggest making copies of image files; it describes detecting and removing duplicate input images. [Geigel at ¶ [0061].] In fact, Geigel teaches away from making and compressing copies: “duplicates and duds [are] *removed* from the system.” [Geigel at ¶ [0077].] As the Examiner acknowledges, “Geigel does not teach compressing the image file copies.” [Office Action at 3.]

Mastronardi describes a process for selecting a recording on a digital audiovisual reproduction system, or in other words a digital jukebox. [Mastronardi at ¶ [0002].] Using user-friendly windows, a user can select a visual or sound recording that is stored in compressed digital form in bulk storage. [Mastronardi at ¶¶ [0008], [0014].] As to type of content, Mastronardi does not involve images *for an album of images*. Moreover, as to operations on content, Mastronardi describes a “reproduction system” that performs decompression and other operations *for playback or presentation of content*; the Mastronardi system does not itself perform compression on content. Accordingly, Mastronardi does not teach or suggest the above-cited language from claims 1, 6, and 11, respectively, and Mastronardi does not make up for the deficiencies of Geigel with respect to claims 1, 6, and 11, respectively.

KBR/JSG:cf 7/13/05 392555.doc 302308.2
PATENT

Attorney Reference Number 3382-63898-01
Application Number 10/058,693

In response to the Applicants' previous arguments as to the claim language discussed above, the Examiner makes two arguments. The Applicants will address them in turn. First, the Examiner "fails to see removing per said citation." [Office Action at 7.] Removal of duplicates and duds in input images is mentioned in paragraph [0077] of Geigel. There, referring to Figure 7, Geigel notes that by the time the images are received by the page layout system 24, "duplicates and duds have been *removed* from the collection."

Second, the Examiner argues that "as to the broadest reasonable interpretation by examiner, performing duplication corresponds to making copies as per teachings of Geigel." [Office Action at 7.] The Applicants respectfully submit that Geigel does not teach performing duplication—it describes detecting duplicates in input images and getting rid of the duplicates. Indeed, paragraph [0061] states that "[d]uplicate and dud *detection* are performed," not that duplication is performed. Moreover, Geigel always discusses duplicates in connection with "duds." Accordingly, Geigel does not teach making duplicate images any more than it teaches making "duds."

For each of claims 1, 6, and 11, neither Geigel nor Mastronardi individually teaches or suggests the above-cited language. Accordingly, the combination of these references also fails to teach or suggest the above-cited language, and claims 1, 6, and 11 should be allowable.

Claims 2, 7, and 12 depend from claims 1, 6, and 11, respectively, and are therefore patentable for the reasons given above with reference to claims 1, 6, and 11. In addition, claims 2, 7, and 12 recite the following language:

- Claim 2: "making a contact sheet image including a user-selected album title having a font and color selected by the user, the contact sheet image further including representations of the images contained in the album";
- Claim 7: "instructing the computing device to make a contact sheet image including an album title and representations of the one or more images contained in the album"; and
- Claim 12: "means for making a contact sheet comprised of a user-selected album title having a font and color selected by the user and including representations of the images contained in the album."

The Examiner cited the page creator module 126 of Figure 7 of Geigel as teaching "making a contact sheet image." [Office Action at 3.] However, "[t]he Page Creator Module 126 is responsible for assigning each image to an album page," not for making a contact sheet image as recited in claims

KBR/JSQ:cf 7/13/05 392555.doc 302308.2
PATENT

Attorney Reference Number 3382-63898-01
Application Number 10/058,693

2, 7, and 12, respectively. [Geigel at ¶ [0077].] The Examiner cited Figures 19-22 as teaching “a user-selected album title having a font.” [Office Action at 3.] However, the alphanumeric characters in Figures 19-22 “are the emphasis values for the particular image,” not a title for an album, or even a title for a particular image. [Geigel at ¶ [0155].] The Examiner cites paragraph [0080] as teaching the color of an album title, but paragraph 80 merely defines the principle of balance. [Compare Office Action at 3 with Geigel at ¶ [0080].] Finally, the Examiner cites paragraph [0056] of Geigel as teaching “the contact sheet image further including an album tile representations of the one or more images contained in the album.” [Office Action at 3.] However, paragraph [0056] in no way teaches or suggests including representations of the album images on a contact sheet image. Thus, Geigel does not teach or suggest an album title or having representations of the album images on a contact sheet image, let alone a contact sheet image including an album title and representations of the album images. In sum, the Applicants respectfully submit that Geigel does not teach or suggest the above-cited language of claims 2, 7, and 12, respectively.

Mastronardi also does not teach or suggest the above-cited language of claims 2, 7, and 12, respectively, and the combination of these references fails to teach or suggest the above-cited language of claim 2, 7, and 12, respectively. Claims 2, 7, and 12 should be allowable.

In response to the Applicants' previous arguments as to the claim language discussed above with reference to claims 2, 7, and 12, the Examiner relies on the doctrine of inherency. Under the doctrine of inherency, the Examiner must show that the allegedly inherent characteristic would “necessarily” result from following the teachings of the prior art reference. [M.P.E.P. 2112, IV. THE EXAMINER MUST SHOW THAT THE ALLEGEDLY INHERENT CHARACTERISTIC NECESSARILY RESULTS FROM THE PRIOR ART; NOT SUFFICIENT TO SHOW THAT IT MAY OCCUR.] The Examiner relies on two paragraphs from Geigel for such inherent teachings: [0056] and [0006]. The Applicants respectfully submit that following the teachings of these two paragraphs either alone or together would not necessarily result in a contact sheet image including a user-selected album title having a font and color selected by the user, the contact sheet image further including representations of the images contained in the album, as recited in claim 2. Similarly, following the teachings of these two paragraphs, either alone or together, would not necessarily result in the above-cited language of claims 7 and 12, respectively.

As discussed above, following the teachings of paragraph [0056] would not even lead to having

KBR/JS:cf 7/13/05 392555.doc 302308.2
PATENT

Attorney Reference Number 3382-63898-01
Application Number 10/058,693

any type of title on the same page as any images, let alone a contact sheet image including a user-selected album title having a font and color selected by the user, the contact sheet image further including representations of the images contained in the album. Following the teachings of paragraph [0056] also would not necessarily result in the above-cited language of claims 7 and 12, respectively.

Paragraph [0006] from the background of Geigel notes the existence of software that "allows the user to annotate the images by entering text, or other data, describing the image." This fails to necessarily result in the above-cited language of claims 2, 7, and 12 for several reasons. First, it does not teach or suggest a title for the *album*, instead referring only to text or data describing a single *image* ("describing the image"). Second, it does not teach or suggest an image including representations of the images contained in the album. Because it does not teach, suggest, or necessarily result in any of these three, it does not teach, suggest, or necessarily result in the combination of them. Therefore, Geigel does not teach (inherently or expressly) or suggest the above-cited language of claims 2, 7, and 12, respectively.

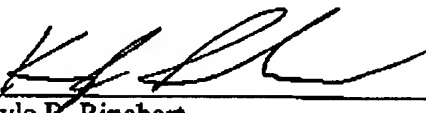
In view of the foregoing remarks, the Applicants will not belabor the merits of the separate patentability of dependent claims 3-5, 8-10, and 13-15 at this point.

Conclusion

The claims in their present form should now be allowed. Such action is respectfully requested. The Examiner is invited to call the undersigned attorney at the telephone number below if the Examiner believes that doing so would further the prosecution of the present application.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By 
Kyle B. Rinehart
Registration No. 47,027

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 226-7391
Facsimile: (503) 228-9446